

**NEIFELD REF:** PIP132HOLM-US

CLIENT REF: PIP132HOLM-US

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FIRST Inventor: ERIC HOLMEN et al.

Title: Targeted Marketing for Subscriptions

Examiner/ArtUnit: SCOTT GARTLAND

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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 APPEAL BRIEF

Sir:

In response to the final office action mailed August 5, 2010 (hereinafter “office action”) and further to the amendment after final canceling claims 87-89 and 91, the appellant files this brief in support of the appeal. The \$540 fee for the appeal, and the \$540 fee for the brief are submitted herewith via EFS credit card authorization.

I. **37 CFR 41.37 (a)(1) AND (2) - NOTICE OF APPEAL, BRIEF, AND FEES**

Claims have been twice rejected. A notice of appeal is filed herewith.

The fee for the Notice of Appeal and for the Appeal Brief are submitted herewith.

II. **37 CFR 41.37(b) - DISMISSAL OF APPEAL IF BRIEF AND FEES UNTIMELY**

The filing is timely. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37(c)(1)**

The brief contains items (i) to (x) of this subsection.

A. **37 CFR 41.37(c)(1)(i) REAL PARTY IN INTEREST**

The real parties in interest are Catalina Marketing Corporation, a Delaware corporation, and Hellman & Friedman LLC, a California LLC.

B. **37 CFR 41.37(c)(1)(ii) RELATED APPEALS AND INTERFERENCES**

There are no related appeals. There are no related interferences.

C. **37 CFR 41.37 (c)(1)(iii) -STATUS OF CLAIMS. A STATEMENT OF THE STATUS OF ALL THE CLAIMS IN THE PROCEEDING (E.G., REJECTED, ALLOWED OR CONFIRMED, WITHDRAWN, OBJECTED TO, CANCELED) AND AN IDENTIFICATION OF THOSE CLAIMS THAT ARE BEING APPEALED**

Claims 1-12, 14-44, 87-89, and 91 are rejected.

Claims 1-12 and 14-43 are pending.

Claims 13 and 44-91 are cancelled.

The appellant appeals the rejections of claims 1-12 and 14-43.

D. **37 CFR 41.37(c)(1)(iv) STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION**

Subsequent to final rejection and concurrent with the filing of this appeal brief, the appellant has filed an amendment to cancel claims 87-89 and 91. The examiner has not acted in response to this amendment at the time of the filing of this appeal brief.

**E. 37 CFR 41.37(c)(1)(v) SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 provides a computer network implemented method (Figure 1 elements 2, 3, 4, 5, 6, 7, 10), comprising: receiving, in a computer system including at least one digital computer including associated central processor, memory, input, and output devices, a CID (Page 6 lines 16-17); determining, using said computer system, whether CID associated data associated with said CID meets invitation offer criteria associated with an invitation code (Page 6 lines 17-19; Page 6 line 28 through page 7 line 27; Page 18 lines 5-8; Page 19 lines 7-11; Page 23 lines 17-22; Figure 7 element 710; Figure 8 element 850); storing, using said computer system, said CID in memory in association with said invitation code when said CID associated data meets said invitation offer criteria (Page 6 lines 17-19; Page 23 line 23 through Page 24 line 4; Figure 4); storing, using said computer system, in association with said invitation code, contract terms comprising terms for a contract for a subscription to a periodical publication (Page 6 lines 19-20); transmitting, to an offer terminal, data defining said CID and said invitation code in order to provide an invitation to a consumer (Page 6 lines 20-22; Page 18 lines 8-11); receiving, from an acceptance terminal, said invitation code in association with said CID subsequent to said transmitting, thereby indicating acceptance of said invitation by said consumer (Page 6 lines 22-23; Page 7 lines 23-27); and storing in computer memory, said CID in association with a transaction tracking code (Page 6 line 24; Page 7 line 27 through Page 8 line 17; Page 17 lines 20-22; Figure 6 element 680).

**F. 37 CFR 41.37(c)(1)(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The rejections of claims 1-12 and 14-43 under 35 USC 102(b) as being anticipated by Walker et al. (U.S. Patent No. 5,926,796) (hereinafter “Walker”) are presented for review because they are improper and should be reversed.

**G. 37 CFR 41.37(c)(1)(vii) ARGUMENT IN WHICH EACH GROUND OF REJECTION IDENTIFIED UNDER SECTION 37 CFR 41.37(c)(1)(vi) IS TREATED IN A SEPARATE SECTION**

See the following sections.

**IV. THE REJECTIONS OF CLAIMS 1-12 AND 14-43 UNDER 35 USC 102(b) AS BEING ANTICIPATED BY WALKER ARE PRESENTED FOR REVIEW BECAUSE THEY ARE IMPROPER AND SHOULD BE REVERSED**

**A. WALKER DOES NOT ANTICIPATE LIMITATIONS IN INDEPENDENT CLAIM 1**

**1. WALKER DOES NOT ANTICIPATE CLAIM 1'S LIMITATION  
“determining, using said computer system, whether CID associated data associated with said CID meets invitation offer criteria associated with an invitation code”**

In support of the rejection of claim 1, the examiner states that Walker discloses “determining, using said computer system, whether CID associated data associated with said CID meets invitation offer criteria associated with an invitation code (11:17-25, POS controller determines whether to provide an upsell offer of a subscription)”. Office action page 8 lines 13-16.

Walker column 11 lines 17-25 states:

If a subscription is available, POS controller 122 sends a periodical subscription upsell query to POS terminal 120 (step 1325). That is, POS terminal 120 displays on display device 250 of POS terminal 120 a message informing the cashier that a subscription is available for the periodical. Pursuant to this prompt, the cashier at POS terminal 120 asks customer 110 whether he desires a subscription to the periodical (step 1330). If the customer responds in the negative, the cashier at POS terminal 120 proceeds with a conventional single-issue sale (step 1335).

In response, the appellant notes that Walker column 11 lines 17-25 discloses sending a periodical subscription upsell query based on the availability of a subscription for a periodical purchased by a consumer. This passage does not disclose any processing based on the identity of the consumer. Therefore, Walker column 11 lines 17-25 does not anticipate “determining, using said computer system, whether CID associated data associated with said CID meets invitation offer criteria associated with an invitation code”, as recited in claim 1. For at least this reason, the rejections of claim 1 and the claims that depend therefrom are improper and should be reversed.

2. **WALKER DOES NOT ANTICIPATE CLAIM 1'S LIMITATION  
“storing, using said computer system, said CID in memory in  
association with said invitation code when said CID associated data  
meets said invitation offer criteria”**

In support of the rejection of claim 1, the examiner states that Walker discloses:

storing, using said computer system, said CID in memory in association with said invitation code **when** said CID associated data meets said invitation offer criteria (8:58-9:17, 9:22-54, 10:4-25; Fig. 8; where the authentication code may be both the CID and the invitation code, or the name and authentication code, all of which is stored in a database that associates the data; furthermore, the offer criteria that is met is the selection or purchase of a single copy); [Office action page 8 lines 17-22; emphasis in original.

Walker column 8 line 58 through column 9 line 17 states:

Local sales database 346 maintains a log of information relating to the subscriptions ordered by customers, such as customer 110. FIG. 7 illustrates a sample of the contents of local sales database 346. As shown in FIG. 7, local sales database 346 contains records having fields corresponding to, for example, date,

sales receipt number, subscription title, subscription price, term of the subscription in months, the amount owed to the wholesaler for the cost of a single issue, and the amount owed to retail subscription system 130 for the cost of a subscription. These last two fields describe the difference between the subscription price and the amount of money retained by the point-of-sale location. For example, as illustrated in FIG. 7, if the price of the subscription is \$20, and if the cost of the single issue is \$2, and if the cost of the subscription is \$10, then the point-of-sale location retains \$8 from the subscription price (i.e., the subscription price charged the customer less the cost of the single issue remitted to the wholesaler and less the cost of the subscription remitted to the retail subscription system). For all of these fields, from the data in this database as well as the data stored in other databases (e.g., local subscription database 342), the data for the corresponding fields can be readily calculated. Additionally, the designated fields may be appended for greater functionality. For example, the records stored in local sales database 346 could be modified to contain additional fields, such as subscriber name and subscriber address.

This passage discloses only storing subscription purchases, not invitation codes.

Walker column 9 lines 22-54 states:

Upon receiving subscription information from POS controller 122, retail subscription system 130 places the information in subscriber database 442. FIG. 8 illustrates a sample of the contents of subscriber database 442. As shown in FIG. 8, subscriber database 442 contains records having fields corresponding to, for example, the store identification number, date, subscriber name, subscriber address, periodical name, term of subscription, authentication code, and number of issues remaining in the subscription. In one embodiment, an operator at retail subscription system 130 receives completed subscription cards corresponding to paid subscriptions and enters information from the subscriptions cards into retail subscription system 130. In an alternative embodiment, POS controller 122 electronically transmits subscription information via data network interface 370 to

retail subscription system 130 via data network interface 480.

RSSAC database 444 contains information allowing retail subscription system 130 to verify the authenticity of the authentication codes transmitted by POS controller 122. FIG. 9 illustrates a sample of the contents of RSSAC database 444. As shown in FIG. 9, RSSAC database 444 contains records having fields corresponding to, for example, store identification number and authentication codes. Each store identification number is preferably associated with a different retailer and is assigned a plurality of authentication codes. In one embodiment, RSSAC database 444 indexes the stored authentication codes by store identification number. Retail subscription system 130 can therefore verify the authenticity of an authentication code transmitted from POS controllers 122 by comparing the received authentication code with the contents of RSSAC database 444.

This passage discloses only the purchased subscriptions database of Fig. 8, not an invitation code.

Walker column 10 lines 4-25 states:

One embodiment of the sale of a subscription at a POS location involves a series of steps illustrated in the flow diagram of FIG. 10. After a customer 110 selects a single issue of a periodical for purchase, a cashier at POS terminal 120 queries customer 110 as to whether customer 110 desires to purchase a subscription to that periodical (step 1010). If customer 110 declines the subscription, the cashier at POS terminal 120 proceeds with a conventional sale of the single issue (step 1015). If customer 110 accepts a subscription, customer 110 completes a subscription card, which customer 110 returns to the cashier at POS terminal 120 (step 1020). Customer 110 preferably obtains a subscription card from within the single issue (i.e., a blow-in card or a bind-in card). Alternatively, the cashier may provide a comparable subscription card to customer 110.

FIG. 11 illustrates a sample subscription card. This sample subscription card contains a space for the subscriber's name, the subscriber's address, and the term of the subscription, as shown in FIG. 11. The sample subscription card may also contain the price for the term of subscription and may indicate alternative terms of subscription and prices.

This passage discloses only filling out a subscription card upon purchase of a subscription, nothing about an invitation code.

As none of the cited passage disclose storing the CID in association with an invitation code, the examiner has not shown that Walker anticipates claim 1's limitation “storing, using said computer system, said CID in memory in association with said invitation code when said CID associated data meets said invitation offer criteria”. For at least this reason, the rejections of claim 1 and the claims that depend therefrom are improper and should be reversed.

3. **WALKER DOES NOT ANTICIPATE CLAIM 1'S LIMITATION  
“storing, using said computer system, in association with said  
invitation code, contract terms comprising terms for a contract for a  
subscription to a periodical publication”**

In support of the rejection of claim 1, the examiner states that Walker discloses “storing, using said computer system, in association with said invitation code, contract terms comprising terms for a contract for a subscription to a periodical publication (8:32-47; name, term, and price)”. Office action page 9 lines 3-5.

Walker column 8 lines 32-47 states:

The data and fields of these databases, as well as the number of databases, can be readily modified from the described embodiment, for example, to include more or fewer data fields.

Local subscription database 342 maintained in POS controller 122



contains a listing of information relating to periodicals to which customer 110 may obtain a subscription at a retailer (e.g., POS terminal 120). FIG. 5 illustrates a sample of the contents of local subscription database 342. As shown in FIG. 5, local subscription database 342 contains records having fields corresponding to, for example, the name of the periodical, the term of subscription, and the price of the subscription. As depicted in FIG. 5, the listing of periodicals may contain different records relating to the same periodical, each record having a different subscription term and price.

All this passage in Walker discusses is a database storing “information relating to periodicals to which a customer 110 may obtain a subscription.” Nothing in that passage refers to storing the CID of the customer “in association with an invitation code”, or doing so only when the CID “meets invitation offer criteria associated with said invitation code;”. Walker indicates that the exemplary database fields are shown in Fig. 5. Fig. 5 shows the fields for the periodical name, subscription term, and price. Fig. 5 does not disclose a CID or “storing said CID in memory in association with an invitation code.”

For at least this reason, the rejections of claim 1 and the claims that depend therefrom are improper and should be reversed.

4. **WALKER DOES NOT ANTICIPATE CLAIM 1'S LIMITATION  
“transmitting, to an offer terminal, data defining said CID and said  
invitation code in order to provide an invitation to a consumer”**

In support of the rejection of claim 1, the examiner states that Walker discloses “transmitting, to an offer terminal, data defining said CID and said invitation code in order to provide an invitation to a consumer (10:40-53, POS terminal displays query to cashier; 11:17-25, POS controller sends prompt POS terminal)”. Office action page 9 lines 6-8; emphasis in original.

Walker column 10 lines 40-53 states:

To indicate the selection of a subscription, the cashier at POS terminal 120 presses a preprogrammed key on POS terminal 120 to indicate that the sale of a subscription has occurred and to obtain an authentication code (step 1050). POS terminal 120 may download a plurality of authentication codes from local authentication code database 344 and temporarily store them in data storage device 240 to be accessed, or alternatively, POS terminal 120 may request an authentication code from POS controller 122 after the preprogrammed key has been pressed. Following the indication of a subscription, POS terminal 120 displays a query to the cashier requesting information about the subscription term and price, which the cashier enters into POS terminal 120 (step 1060).

This passage in Walker discusses what the sales clerk does after the customer has purchased a subscription from the sales clerk. This passage refers to the clerk obtaining an authentication code in response to pressing a key indicating that the sale of the subscription has occurred. Nothing therein discloses providing an invitation code to a customer to purchase a subscription.

Walker column 11 lines 17-25 is copied above. As noted above, this passage does not disclose any processing based on the identity of the consumer. Moreover, this passage does not disclose providing an invitation code to a customer to purchase a subscription.

As none of the cited passage disclose providing an invitation code to a customer to purchase a subscription, the examiner has not shown that Walker anticipates claim 1's limitation "transmitting, to an offer terminal, data defining said CID and said invitation code in order to provide an invitation to a consumer". For at least this reason, the rejections of claim 1 and the claims that depend therefrom are improper and should be reversed.

## **VI. 37 CFR 41.37(c)(1) CONTINUED**

### **H.. 37 CFR 41.37(c)(1)(viii) - CLAIMS APPENDIX**

The brief includes an appendix containing a copy of the claims involved in the appeal.

**I. 37 CFR 41.37(c)(1)(ix) - EVIDENCE APPENDIX**

The brief contains an appendix complying with the requirement for such an appendix. However, no evidence is submitted.

**J. 37 CFR 41.37(c)(1)(x) RELATED PROCEEDINGS APPENDIX**

The brief contains an appendix complying with the requirement for such an appendix. However, no related proceedings exist.

**VII. 37 CFR 41.37 (c)(2)**

This brief does not include any new or non-admitted amendment or evidence.

**VIII. 37 CFR 41.37 (d)**

This appeal brief complies with all the requirements of paragraph (c) of this section.

**IX. 37 CFR 41.37 (e)**

This notice of appeal and appeal brief are timely filed. Accordingly, no extensions of time are necessary.

Respectfully Submitted,

/BruceMargulies#64,175/

**DATE:**11/4/2010

Bruce Margulies, Reg. No. 64,175

Attorney of record

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## APPENDIX 1 - CLAIMS APPENDIX OF APPEALED CLAIMS

1. A computer network implemented method, comprising:
  - receiving, in a computer system including at least one digital computer including associated central processor, memory, input, and output devices, a CID;
  - determining, using said computer system, whether CID associated data associated with said CID meets invitation offer criteria associated with an invitation code;
  - storing, using said computer system, said CID in memory in association with said invitation code when said CID associated data meets said invitation offer criteria;
  - storing, using said computer system, in association with said invitation code, contract terms comprising terms for a contract for a subscription to a periodical publication;
  - transmitting, to an offer terminal, data defining said CID and said invitation code in order to provide an invitation to a consumer;
  - receiving, from an acceptance terminal, said invitation code in association with said CID subsequent to said transmitting, thereby indicating acceptance of said invitation by said consumer; and
  - storing in computer memory, said CID in association with a transaction tracking code.
2. The method of claim 1 further comprising determining whether consumer data associated with said CID meets said invitation offer criteria.
3. The method of claim 2 wherein said invitation offer criteria comprises criteria for POS data.
4. The method of claim 2 wherein said invitation offer criteria comprises criteria for block data.
5. The method of claim 2 wherein said invitation offer criteria comprises criteria for preference data.

6. The method of claim 2 wherein said invitation offer criteria comprises criteria for profile data.

7. The method of claim 2 wherein said invitation offer criteria comprises criteria for demographic data.

8. The method of claim 2 wherein said invitation offer criteria comprises criteria for magazine purchases.

9. The method of claim 1 wherein said contract terms comprise a name of said periodical publication.

10. The method of claim 1 wherein said contract terms comprise a price for said subscription.

11. The method of claim 1 wherein said contract terms comprise an expiration date for said invitation.

12. The method of claim 1 wherein said contract terms include terms of an incentive offer.

13. (Canceled).

14. The method of claim 12 wherein said terms of said incentive offer include a cash discount.

15. The method of claim 1 wherein said transmitting comprises transmitting when said CID is involved in a transaction at said offer terminal.

16. The method of claim 1 further comprising updating an invitation offer record in an invitation offer database to indicate that code associated with said record has been used in an invitation offered to a customer.

17. The method of claim 16 wherein said invitation offer record also stores at least one of the following items: a name of a periodical publication, a subscription price, an offer expiration date, and an incentive offer.

18. The method of claim 16 wherein said invitation offer record also stores at least two of the following items: a name of a periodical publication, a subscription price, an offer expiration date, and an incentive offer.

19. The method of claim 1 further comprising either generating or updating a consumer invitation record in a consumer invitation database to store a CID and a unique code.

20. The method of claim 19 wherein said consumer invitation record also stores at least three of the following items: a name of a periodical publication, a subscription price, an invitation expiration date, an incentive offer, and a subscription term.

21. The method of claim 19 wherein said consumer invitation record also stores at least four of the following items: a name of a periodical publication, a subscription price, an invitation expiration date, incentive offer, subscription term.

22. The method of claim 19 wherein said consumer invitation record also stores data indicating whether said invitation has been provided to said consumer.

23. The method of claim 1 further comprises receiving payment for said subscription when receiving from said acceptance terminal said invitation code.

24. The method of claim 23 further comprising receiving payment for product purchases concurrently with receiving said payment for said subscription.

25. The method of claim 1 further comprising generating a consumer confirmation record in a consumer confirmation database after receiving from said acceptance terminal said invitation code.

26. The method of claim 25 wherein said consumer confirmation record includes a CID and a transaction tracking code.

27. The method of claim 26 wherein said consumer confirmation record also includes at least one of the following items: a name of a periodical publication, a subscription price, a subscription term, a confirmation activation expiration date, an incentive offer, and an incentive offer expiration date.

28. The method of claim 26 wherein said consumer confirmation record also includes at least two of the following items: a name of a periodical publication, a subscription price, a subscription term, a confirmation activation expiration date, an incentive offer, and an incentive offer expiration date.

29. The method of claim 1 wherein at least one criteria of said invitation offer criteria is whether a magazine is purchased.

30. The method of claim 1 wherein at least one criteria of said invitation offer criteria is whether said consumer is in a specified top fraction of spenders.

31. The method of claim 1 wherein said invitation is provided to said consumer via direct mail.

32. The method of claim 1 wherein said invitation is provided to said consumer via printing at an in-store printer.

33. The method of claim 1 further comprising activating said subscription.

34. The method of claim 33 wherein said activating comprises receiving at an activation center a telephone call from said consumer.

35. The method of claim 33 wherein said activating comprises receiving a mailing from said consumer.

36. The method of claim 33 wherein said activating comprises receiving activation data transmitted by said consumer over the Internet.

37. The method of claim 1 further comprising printing said invitation and including a printed unique bar code.

38. The method of claim 37 wherein magazine name, magazine subscription price, and offer expiration date are encrypted in said unique bar code.

39. The method of claim 1 wherein magazine name, magazine subscription price and offer expiration date are encrypted in said transaction tracking code.

40. The method of claim 1 further comprising providing at least two of the following items: a retail store computer system, a central computer system[[:]], an activation center computer system, a publisher computer system, a mailing facility computer system, and a coupon clearing house computer system.

41. The method of claim 1 further comprising providing at least three of the following



items: a retail store computer system, a central computer system; an activation center computer system, a publisher computer system, a mailing facility computer system, and a coupon clearing house computer system.

42. The method of claim 1 further comprising storing POS data in association with CIDs in a consumer data database.

43. The method of claim 42 wherein said consumer data database also stores in association with CIDs at least one of the following items: profile data, preference data, demographic data, and block data.

## **APPENDIX 2 - EVIDENCE APPENDIX**

There is no evidence to be cited herewith.

### **APPENDIX 3 - RELATED PROCEEDINGS APPENDIX**

There are no related proceedings to be cited herewith.

BTM

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